The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED
JAN 28 2005
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY M. GROSS
and MATTHEW H. PARKER

Appeal No. 2004-0953
Application No. 09/215,593

HEARD: January 13, 2005

Before HAIRSTON, LEVY, and NAPPI, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-17 and 19-22, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an electronic document proofing system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A system for proofing electronic documents delivered over a network comprising:

a plurality of electronic documents in portable document file format;

a computer connectable to the network for receiving the plurality of portable format documents together with at least one associated proofer identifier;

a program executing on said computer for assigning a version number to each of the plurality of received portable format documents; and

a database accessible by said computer for storing the documents and associated version numbers;

said computer for receiving a request, from a proofer presenting the proofer identifier, to review multiple versions of a portable format electronic document;

said program for retrieving and formatting the requested multiple document versions for simultaneous display to permit visual comparison.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ogawa	5,438,661	Aug. 1, 1995
Smith et al. (Smith)	5,790,790	Aug. 4, 1998
Plantz et al. (Plantz)	6,088,702	Jul. 11, 2000 (filed Feb. 25, 1998)
Aoyama et al. (Aoyama)	6,301,592	Oct. 9, 2001 (filed Nov. 4, 1998)

Adobe Acrobat Review, Adobe Acrobat 3.0, ("Adobe Acrobat 3.0), 1993

Claims 1-17 and 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Plantz, Aoyama, Ogawa and Adobe Acrobat Review.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 11, mailed March 24, 2003) for the examiner's complete reasoning in support of the rejection, and to appellants' brief (Paper No. 10, filed March 5, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse.

Before we address the limitations of the claims, we note the general principles that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). The examiner's position (answer, pages 3-6) is that Smith discloses a system for delivering a portable document format to a server. The examiner asserts that Smith does not disclose a means with which the documents can be proofed. To overcome this deficiency of Smith, the examiner turns to Plantz for a teaching of a group publishing system in which an unlimited number of authors and editors can perform word processing, document assembling and editing functions on various portions of documents in a project. The examiner also relies upon Plantz for a teaching of access control for preventing unauthorized access, and allows users to edit documents in the project. The examiner adds (answer, page 4) that Plantz does not disclose assigning version numbers to documents that have been modified. To overcome this deficiency of Plantz, the examiner turns to Aoyama for a system for displaying version information, as well as for

providing storage for the version information. The examiner adds (answer, page 5) that Aoyama does not disclose a visual comparison of the various versions. To make up for this deficiency of Aoyama, the examiner turns to Ogawa for a teaching of comparing different versions on the same screen to ease the editing process. The examiner adds (answer, page 6) that both Plantz and Aoyama do not disclose a system in which the documents being edited are portable document file formats. To overcome this deficiency in Plantz and Aoyama, the examiner turns to Adobe Acrobat 3.0 which allows users to edit a portable document file (pdf).

We note at the outset that appellants do not dispute the fact that the prior art references disclose all of the limitations of the claims, rather, appellants assert (brief, page 7) that there is no suggestion to combine the teachings of the prior art, and that the references teach away from combination. It is argued (brief, page 11) that even if the invention could somehow be pieced together from various elements of the five cited references, it would have been necessary to utilize the claimed invention as a roadmap in order to do so.

From our review of the entire record, we are in agreement with appellants that the examiner has pieced together the

invention set forth in appellants claims by using the claimed invention as a roadmap. The examiner (answer, page 3) relies upon the primary reference to Smith for a system of delivering a portable document format to a server. The examiner goes on to piece together the other elements of the claim, with the four secondary references; i.e., the examiner relies upon Plantz for an Internet-based group publishing system with a plurality of authors and editors, as well as for access control, and relies upon Aoyama, Ogawa and Adobe for teachings of the assignment of version numbers, storage of all versions, simultaneous visual comparison of different versions, and the documents being edited in pdf format. Turning to the additional references, while they are combinable among themselves, we find no teaching to combine these references with Smith and Plantz to arrive at appellants' invention, other than from reliance on appellants' disclosure.

We are not persuaded by the examiner's assertion (answer, page 4) that "[b]oth Plantz and Smith are of analogous art in the field of document processing," as the apparent motivation for combining the teachings of the prior art to arrive at the claimed invention. The mere fact that the prior art references are analogous and could be modified in the manner suggested by the Examiner does not make such a modification obvious unless the

prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In sum, we find that to arrive at appellants' invention, the examiner has started with Smith's disclosure of delivering a portable document format to a server, and has added the additional references in a hindsight reconstruction of appellants' invention using appellants' claims as a roadmap for combining the teachings of the prior art. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1-17 and 19-22.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-17 and 19-22 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge)

STUART S. LEVY
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

ROBERT E. NAPPI
Administrative Patent Judge)

SSL/kis

WESKEY W. WHITMYER, JR.
ST. ONGE STEWARD JOHNSON & REENS
986 BEDFORD STREET
STAMFORD, CT 06905